

REMARKS

I. Introduction

In response to the Office Action dated April 29, 2005, Applicants have amended claims 1 and 11 so as to incorporate the claimed subject matter recited by claims 5 and 15, respectively. Applicants note that the present Amendment does not generate any new issue, because the present Amendment merely incorporates the limitations of claims 5 and 15 into claims 1 and 11, respectively.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Rejection Of Claims 11-16 Under 35 U.S.C. § 102

Claims 11-16 and 19-20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by USP No. 5,748,084 to Isikoff. Applicants respectfully traverse this rejection for at least the following reasons.

In the previous Response, Applicants argued, “the beacon 101 of the computer 100 of Isikoff does not have the capability to detect the geographic position of the computer 100.” In the statement of rejection, citing col. 10, lines 26-29 of Isikoff, the Examiner asserted, “[T]o aid in the tracking process, GPS receiver may be included in some embodiments and the transmitter may transmit its position coordinates.”

However, Applicants respectfully submit that this analysis overlooks the fact that the GPS receiver disclosed at the cited portion of Isikoff is directed to a paging network/system 200 (see, Fig. 6), and is *not* related to the alleged portable information-processing device or the laptop 100 (see, Fig. 4). Accordingly, the Examiner’s interpretation that the GPS receiver can be

included in the laptop 100 departs from the disclosure of Isikoff, and nothing in Isikoff suggests otherwise.

Furthermore, the pending rejection alleges that Isikoff discloses incorporating large transmitters or GPS receivers and position data transmitters (see, col. 1, lines 26-34). However, this incomplete analysis, again, ignores the fact that Isikoff expressly discloses "... solutions like those offered for automobiles [such as] incorporating large transmitters or GPS receivers ... are too *unwieldy* for incorporation in a laptop (see, col. 1, lines 29-31)." That is, Isikoff specifically teaches away from the claimed invention in that Ishikoff desirably suggests *not* to incorporate GPS receivers and position data transmitters in a laptop. This is evidenced by the fact that such implementation would be economically prohibitive or result in poor performance when located within a building (see, col. 1, lines 33-35). Thus, it is respectfully submitted that Isikoff fails to disclose or suggest "a method of evacuating data for portable information-processing device, wherein the portable information-processing device is capable of geographically identifying its own location." Indeed, Ishikoff teaches away from such a method.

Moreover, it is alleged that tracking the geographic position of the computer by the combination of RF transmission signal from the beacon 100 with the help of the apparatus 120 as opposed to tracking the geographic position of the computer by installing the GPS to identify its own location is a matter of design choice (see, page 4, lines 3-12 of Office Action).

As a preliminary matter, it is respectfully submitted that this statement as a conclusion to the rejection is not a proper basis for rejecting Applicants' claims, as this allegation is directed to an *opinion* rather than what is taught by the prior art. It is submitted that opinion cannot be relied on to replace the deficiency of a prior art reference. If the pending rejection intended to take Official Notice that the differences between Isikoff and the present invention as recited in

the rejected claims are well-known in the art, then pursuant to M.P.E.P. § 2144.03, Applicants respectfully traverse such an assertion and request the next Office Action to cite one or more references in support of this position (see, second paragraph, last three lines of M.P.E.P. § 2144.03, which requires the Examiner to cite a reference in support of his allegation of Official Notice when Applicants traverse). In this regard, Applicants respectfully submit that the allegation that the differences between Isikoff and the present invention as recited in the rejected claims are a matter of *design choice does not qualify* within the meaning of 35 U.S.C. § 102(b). Even assuming *arguendo* that such an opinion has merit, Isikoff, as discussed above, expressly discusses the disadvantages of installing GPS receivers and position data transmitters onto a laptop (see, col. 1, lines 30-35), so that having the alleged portable information-processing device geographically identify its own location is *not* a design choice as perceived by the Examiner. Accordingly, it is respectfully submitted that the rejection of claims 11-16 and 19-20 under 35 U.S.C. § 102 is improper, and should be withdrawn.

Further, it is noted that the Examiner maintains the rejection of claim 15. As the subject matter of claim 15 has been incorporated into claim 11, Applicants will treat the rejection to claim 15 as applicable to claim 11. Specifically, claim 11, as amended, recites in-part that the data stored in said storage means is deleted, in any of events that transmission of the data to said pre-assigned device is not initiated, and that the transmission is interrupted.

In the pending rejection, the Examiner continues to rely upon col. 1, lines 62-63 and col. 8, lines 42-45 of Isikoff as allegedly disclosing the foregoing claimed feature. However, Applicants respectfully submit that the cited portion mentions nothing more than augmenting a security protocol, transmitting the sensitive data and carrying out the destruction of the data. In other words, the cited portion is completely silent with regard to how the foregoing processes are

carried out *in relation to* the alleged pre-assigned device (i.e., the clearing house service center). The only section of Isikoff suggesting the use of a clearing house service center is found in col. 8, lines 21-30. In this regard, it should also be noted this portion of Isikoff only discloses initiating a transfer of the critical files through the central clearing house service center operated by a security company that provides broad-area RF/cell phone coverage and temporary storage for such critical files. That is, the assumption of Isikoff underlines that the transmission of the critical files from the laptop and the beacon of the laptop functions normally and is shielded from any interruption, so that upon receipt of the lower level codes, the document recovery request and the codes can be executed, resulting in the transmission of the files back to the owner (see, col. 8, lines 39-42). For all of the foregoing reasons, Applicants respectfully submit that Isikoff does not disclose or suggest “the data stored in said storage means is deleted, in any of events that transmission of the data to said pre-assigned device is not initiated, and that the transmission is interrupted,” as recited by claim 11.

As anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a minimum, Isikoff fails to disclose or suggest the foregoing claim elements, it is clear that Isikoff does not anticipate claim 11 or any of the claims dependent thereon.

III. The Rejection Of Claims 1-10 and 17-18 Under 35 U.S.C. § 103

Claims 1-10 and 17-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Isikoff in view of USP No. 6,356,196 to Wong. As noted that the Examiner maintains the rejection of claim 1 for the same reasons applied to claim 11, Applicants respectfully submit that

the foregoing arguments and distinctions with respect to rejection of claim 11 as set forth above are also applicable to claim 1.

Also, Applicants previously argued, “Wong, on the other hand, merely discloses a tracking beacon 4 for emitting either a violation radio signal or a delivery confirmation signal” and “the tracking beacon 4 of Wong only broadcasts a radio signal indicating the status of the parcel 3 (see, col. 7, lines 11-12), and does not broadcast any location information of the parcel 3 to the microprocessor 10.” However, as the “Response to Applicants’ Argument” section of the pending Office Action does not set forth reasons why Applicants’ argument does not overcome the proposed combination of Isikoff and Wong, if the pending rejection is maintained, it is respectfully requested that the next Office provide details regarding why Applicants’ argument is deficient so that Applicants may further address these issues in the next Response. In this regard, it should also be noted that the motion detector detects only the unauthorized movement of the parcel. However, it is clear that the motion detector is incapable of detecting the ***position*** or location of the parcel.

For all of the foregoing reasons, it is respectfully submitted that claim 1 is patentable over the cited prior art.

IV. All Dependent Claims Are Allowable Because The Independent Claims From Which They Depend Are Allowable

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as independent claims 1 and 11 are

patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also in condition for allowance.

V. Conclusion

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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